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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,144	12/17/1999	Jaya Shankar Pathmasuntharan	004404.P002	9823

7590 02/04/2004

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EXAMINER

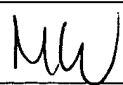
LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/466,144	PATHMASUNTHARAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12,60-69 and 90-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,60-69 and 90-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 04 October 2003.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-12, 60-69 and 90-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Teicher et al (US 6,257,486).

Re claims 1-12, 60-69 and 90-96: Teicher et al discloses in fig. 11: a smart card 1100 comprising an interface with a smart card reader 1200, first circuitry 1105 configured to receive a first enable signal from a smart card enabler, and second circuitry 854 coupled with the interface and first circuitry 1105 and configured to allow the smart

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card 1100 to function with the smart card reader 1200 based on the first enable signal; wherein the first circuitry 1105 is also configured to receive a second enable signal from the smart card enabler, and wherein the second circuitry 854 is also configured to allow the smart card to perform a transaction with the smart card reader 1200 based on the second enable signal; wherein the first enable signal and the second enable signal are radio frequency signals (fig. 2; col. 2, lines 14+); wherein the second circuitry 854 is also configured to disable the smart card 1100 to function with the smart card reader 1200 if the first circuitry does not receive the first enable signal (fig. 12; col. 14, lines 39+); wherein the second circuitry 854 is also configured to disable the smart card to perform the transaction with the smart card reader if the first circuitry does not receive the second enable signal (figs. 6 & 23; col. 6, line 5+); wherein the second circuitry 854 is also configured to disable the smart card to perform the transaction after a predetermined time period (figs. 6 & 23; col. 6, line 21+); wherein the second circuitry 854 performs the transaction with the smart card reader 1200 through the interface after receiving the first enable signal and the second enable signal (fig. 3; col. 4, lines 6+); wherein the second circuitry 854 performs the transaction for the smart card 1100 that is within a close proximity of the smart card enabler (figs. 5A-5B; col. 5, lines 5+); wherein the second circuitry 854 includes a memory storing first identification key and a first transaction key (col. 6, lines 38+); and a central processing unit 856 coupled to the memory and configured to send the first identification key and first transaction key to the smart card enabler, and wherein the first enable signal and the second enable signal are received from the smart card enabler based on the first identification key and first transaction key (fig. 11; col. 14, lines 20+); wherein the memory also stores a first transaction value, the

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first transaction value representing an available amount of hard currency in electronic form for the smart card, and wherein the central processing unit 856 is also configured to send the first transaction value to the smart card enabler such first transaction value is stored in the smart card enabler; wherein the central processing unit 856 is also configured to generate a second transaction value as a result of a transaction and replace the first transaction value with the second transaction value. 12 (fig. 8A-C; col. 9, lines 1+); wherein the central processing unit 856 is also configured to generate a second transaction key to replace the first transaction key and transmit the second transaction key and second transaction value to the smart card enabler; wherein the smart card 400 comprises a key pad 404 and a display 402 (fig. 3); wherein the smart card 1100 is further configured to create and store a new transaction key as a consequence of a new transaction value having been received from the smart card reader 1200, the new transaction key stored into the memory resource, the new transaction value reflecting the transaction value less a cost for the transaction (e.g., in order to display the most current monetary value contained within the smart card) (fig. 8A-C; col. 9, lines 1+).

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 60 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited reference to Teicher et al has been used in the new ground rejection to further meet the limitation of the claimed invention.

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*Conclusion*


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The patents to Wallerstein (US 5,955,961); Boston (US 4,766,293) are cited as of interest and illustrate a similar structure to an apparatus and system of a method and system of using a smart card.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Uyen-Chau N. Le  
January 18, 2004

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800